

AFTER 10 DAYS RETURN TO:
Organization TC 3600

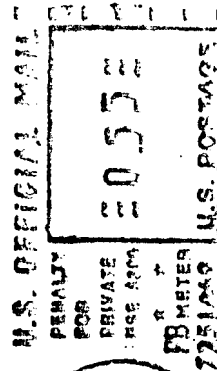
Bldg./Rm. PK5-6D11

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UNITED STATES DEPARTMENT OF COMMERCE
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Handwritten initials: MV

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/320,649 05/27/99 MORI

N P725-9009

PM82/0411
NIKAIDO MARMELSTEIN MURRAY & ORAM LLP
METROPLITAN SQUARE
SUITE 330-G STREET LOBBY
WASHINGTON DC 20005-5701

EXAMINER

FOOTLAND, L

ART UNIT	PAPER NUMBER
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3682

Handwritten: 13

DATE MAILED:

04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RECEIVED

APR 23 2001

TO 3600 MAIL ROOM

Office Action Summary

Application No.

Applicant(s)

Examiner

Lenard A. Footland

Group Art Unit

3682



☒ Responsive to communication(s) filed on Mar 2, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6-9, and 11-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 11-24 is/are allowed.

☒ Claim(s) 1-4 and 6-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3-23-01

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3682

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There appears to be no disclosure of an "an inner diameter ... at the endless circumferential groove ... greater than inner diameters at ridges".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-9, as understood, are rejected under 35 U.S.C. § 102(b), as being anticipated by Mori et al. The examiner finds all claimed subject matter to be present.

See Fig. 1.

Art Unit: 3682

There is reason to believe, based on the similarity of lubricating materials, that the functional limitations thereof may be inherent characteristics of the reference materials. In accordance with *In re Best*, 562 F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

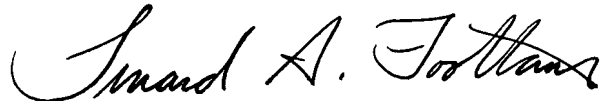
Accordingly, the burden is placed upon the applicant to prove that the functional limitations in question are not inherent characteristics of the reference materials.

Claims 11-22 and 23-24 are allowed.

Art Unit: 3682

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (703) 308-2683.

A handwritten signature in cursive script that reads "Lenard A. Footland".

LENARD A. FOOTLAND
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600
ART UNIT 3682

laf
April 10, 2001

FORM PTO-1449

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

100725-09009

SERIAL NO.

09/320,649

LIST OF REFERENCES CITED BY APPLICANT

(Use several sheets if necessary)

APPLICANT

MORI et al.

FILING DATE

May 27, 1999

GROUP

3682

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLAS S	FILING DATE
TAP	AA	5,022,492	June 11, 1991	OHNO et al.	184	5	April 17, 1989
↓	AB	5,707,944	January 13, 1998	YOKOUCHI et al.	508	485	October 17, 1995
↓	AC	5,746,516	May 5, 1998	MIYASAKA et al.	384	291	August 8, 1996
	AD						
	AE						
	AF						

FOREIGN PATENT DOCUMENTS

		DOCUME NT NO.	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO PART.		
TAP	AG	10068418	October 3, 1998	Japan	—	—			X
↓	AH	WO 97/16828	May 9, 1997	WO	—	—	X		
↓	AI	292 673 A5	August 8, 1991	Germany	—	—		X	
↓	AJ	2,064,676	June 17, 1981	GB	—	—	X		
↓	AK	2,320,743	July 1, 1998	GB	—	—	X		
	AL								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

	AM	
	AN	
	AO	

EXAMINER

L. Footland

DATE CONSIDERED

4-10-01

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.